

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IDG Books Worldwide, Inc.

Serial No. 74/650,282

Mark B. Harrison for IDG Books Worldwide, Inc.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

IDG Books Worldwide, Inc. (applicant) seeks to register on the Supplemental Register WEBMEDIA in typed drawing form for "books in the field of computers, communications and information technology." The intent-to-use application was filed on March 22, 1995. On February 12, 1997 applicant submitted an amendment to allege use, along with three specimens showing use of its mark. The specimens were the front cover of one of applicant's books. This specimen is reproduced below.

Ser. No. 74/650,282

Ser. No. 74/650,282

The Examining Attorney has refused registration on the basis that applicant's "drawing displays the mark as WEBMEDIA" and that "this differs from the display of the mark on the specimen, where it appears as WEBMEDIA MAGIC." (Examining Attorney's brief page 4). When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

The leading case dealing with a situation where an applicant attempts to register what is arguably only a part of its trademark is In re Servel, Inc., 181 F.2d 192, 85 USPQ257 (CCPA 1950). In that case, applicant sought to register SERVEL despite the fact that the specimens of use showed that the title of applicant's periodical was SERVEL INKLINGS. In reversing the refusal to register SERVEL per se, the Court stated that "the courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of two parts." 85 USPQ at 260.

In view of the holding in Servel, the Board has been quite liberal in allowing applicants to register what are arguably only portions of the trademarks shown on the

Ser. No. 74/650,282

specimens of use. For example, this Board allowed registration of DUMPMMASTER based upon the following specimen of use:

In so doing, this Board stated that "there can be no question but that the composite shown above constitutes two distinct terms, each of which is capable of distinguishing applicant's goods from like goods, if they were to be used separably as trademarks." In re Dempster Bros., Inc., 132 USPQ 300 (TTAB 1961). In allowing registration of DUMPMMASTER per se, the Board was not troubled by the fact that the words DEMPSTER and DUMPMMASTER were totally intertwined in that they shared the same large first letter and the same large final letter (i.e. the D and the R).

In a more recent decision, this Board allowed the registration of the mark TINEL-LOCK based upon the following specimen of use:

In so doing, the Board was not concerned with the fact that the mark sought to be registered (TINEL-LOCK) was joined with hyphens to the model number (TR06AI) and the generic term (RING). In re Raychem Corp., 12 USPQ2d 1399 (TTAB 1989).

In stark contrast to the Dempster and Raychem cases, in the present case the mark sought to be registered (WEBMEDIA) is physically separated from the word MAGIC in that the term WEBMEDIA is totally enclosed within a rectangle. The word MAGIC is not within the same rectangle. Indeed, the word MAGIC is not within any rectangle or other enclosure. Moreover, extending from the lower left portion of the rectangle enclosing the term WEBMEDIA is a line which bypasses the word MAGIC and directs the reader's attention to the following words: "A Practical Guide to Building Multimedia Web Sites." These words describe with greater particularity the nature of applicant's goods, namely, "books in the field of

computers, communications and information technology."

In view of the foregoing, we find that as depicted in applicant's specimens of use, the word WEBMEDIA clearly stands apart from the word MAGIC. By seeking registration on the Supplemental Register, applicant has arguably conceded that the word WEBMEDIA is merely descriptive of its "books in the field of computers, communications and information technology." However, if through use the word WEBMEDIA acquires distinctiveness indicating applicant's particular books, then based upon the specimens of use, we find that consumers would view WEBMEDIA per se as applicant's mark.

Decision: The refusal to register on the basis that WEBMEDIA per se could not in the future function as applicant's mark based upon the specimens of use is reversed.

